

REMARKS

The present Amendment amends claims 5-8. Therefore, the present application has pending claims 5-8.

The Examiner's cooperation is respectfully requested to contact Applicants' Attorney by telephone so as schedule an interview to discuss the outstanding issues of the present application prior to examination.

Claims 5-8 stand rejected under 35 USC §102(b) as being anticipated by Harrington (U.S. Patent No. 5,546,454) in view of the alleged legal precedence of making separable as set forth in MPEP §2144.04. This rejection is traversed for the followings reasons. Applicants submit that the features of the present invention as now recited in claims 5-8 are not taught or suggested by Harrington or the alleged legal precedence of making separable as set forth in MPEP §2144.04 whether taken individually or in combination with each other as suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

It appears from the comments made by the Examiner in the Office Action that the Examiner does not have a full understanding of the present invention as recited in the claims. In the Office Action, the Examiner alleges that:

“it is well known in the art to provide, wherein the hold control means the hold release means are separate from the transfer means as taught by legal precedence making separable”.

It appears from the above that the Examiner has completely misunderstood the present invention and has not properly applied the procedures as set forth in MPEP 2144.04. The very first part of this section of the MPEP specifically state that:

“if the Applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely a case law as the rationale to support an obviousness rejection”.

In the Office Action, the Examiner merely relies on such alleged legal precedence of making separable without identifying any such teaching in any of the references of record or any motivation in Harrington that such a modification is possible or desired. Thus, the Examiner is simply relying on case law to support an obviousness type rejection to modify a cited reference when Applicants have argued continually and have demonstrated convincingly that the limitation recited in the claims is critical to the features of the present invention thereby distinguishing the features of the present invention from the references of record.

Thus, based on the above, an interview is deemed appropriate and necessary. The interview should be held with the Examiner and the Examiner's Primary Examiner Minsun Oh Harvey and/or the Examiner's Supervisor Examiner Forester W. Isen so that the issues regarding the appropriateness of basing an obviousness rejection solely on case law to modify a cited reference can be resolved.

As in aid in clarifying the features of the present invention that are different from Harrington, the present Amendment amends the claims so as to more clearly recite that the present invention includes a plurality of display means each provided

in association with each of a plurality of common hold operation means, each of which accepts the hold instruction and performs a display showing a "hold state" when a corresponding common hold operation means is operated, and accepts the hold release instruction and performs a display showing a "no hold state" when the corresponding common hold operation means is operated during the display showing the "hold state" thereof.

The claims were amended to further recite that the present invention includes an exchange having a hold control means for holding the first forwarding address telephone under communication with one of the telephones whose communication partner is held by the transfer control means to associate with a first common hold operation means as one of the common hold operation means in the telephone, whose corresponding display means performs the display showing the "no hold state", making the corresponding display means corresponding to the first common hold operation means in the one telephone perform the display showing the "hold state" and allowing the one telephone to request for connection with a second forwarding address telephone, in accordance with the hold instruction accepted by the first common hold operation means, and a hold release means for releasing the first forwarding address telephone held in association with the first common hold operation means, connecting the first forwarding address telephone thus released with the one telephone and making the corresponding display means corresponding to the first common hold operation means in the one of the telephones perform the display showing the "no hold state", in accordance with the release instruction accepted by the first common hold operation means.

In the Office Action, the Examiner alleges that it is known to provide the hold control means and the hold release means separately from the transferring means of Harrington based upon the alleged legal precedence making separable as set forth in MPEP 2144.04. However, it should be noted that in Harrington only one line can be kept in a hold state in a normal extension phone with holding function. Thus, in Harrington, when an extension phone is performing transfer communication which is a communication with a first forwarding address telephone (extension), while a communication partner (public line) is kept in a hold state, and when a user of the extension telephone wants to hold the first forwarding address telephone, the user must release the line of the communication partner. Thus, as taught by Harrington plural calls cannot be kept on hold as in the present invention.

In the present invention, in the situation described above, a user can communicate with a second forwarding address telephone without releasing the hold of the communication partner and the first forwarding address telephone. Thus, according to the present invention, in the extension phone, plural calls can be kept on hold at the same time contrary to that taught by Harrington. Therefore, there is absolutely no teaching or suggestion in Harrington of a configuration wherein one extension telephone can hold plural calls at the same time as in the present invention as recited in the claims. The present invention as recited in the claims accomplishes these features by providing the hold control means and the hold release means which are clearly not taught or suggested by Harrington.

Therefore, Harrington fails to teach or suggest hold control means for holding the first forwarding address telephone under communication with the one telephone

whose communication partner is held by the transfer control means to associate with a first common hold operation means as one of the plurality of common hold operation means in the one telephone, whose corresponding display means performs the display showing "no hold state", making the corresponding display means corresponding to the first common hold operation means in the one telephone performed the display showing the "hold state" and allowing the one telephone to request connection with a second forwarding address telephone in accordance with the hold instruction accepted by the first common hold operation means as recited in the claims.

Further, Harrington fails to teach or suggest hold release means for releasing the first forwarding address telephone held in association with the first common hold operation means, connecting the first forwarding address telephone thus released with the one telephone, and making the corresponding display means corresponding to the first common hold operation means in the one telephone performed the display showing "no hold state", in accordance with the release instruction accepted by the first common hold operation as recited in the claims.

The extension terminal taught by Harrington shows plural line keys. These plural line keys correspond to the plurality of common hold operation means of the present invention as recited in the claims. However, at no point is there any teaching or suggestion in Harrington of a configuration wherein one telephone can hold plural lines as in the present invention. In Harrington, the internal (extension) telephone unit 32a holds the external (outside line) telephone unit 28 and the internal telephone unit 32b holds the internal telephone unit 32a. Thus, as taught by Harrington, the

internal telephone unit 32a and the internal telephone unit 32b each hold one telephone line respectively. There is no teaching or suggestion in Harrington of a configuration wherein one extension telephone unit (internal telephone units 32a, 32b, 32c and 32d) simultaneously holds plural calls nor disclose that one extension telephone unit simultaneously holds plural calls as in the present invention as recited in the claims.

Thus, for the reasons noted above, the features of the present invention are clearly not taught or suggested by Harrington and as such would not be obvious when applying the alleged legal precedence of making separable as set forth in MPEP 2144.04. Therefore, reconsideration and withdrawal of the 35 USC §103(a) rejection of claims 5-8 as being unpatentable over Harrington in view of the alleged legal precedence of making separable as set forth in MPEP 2144.04 is respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references utilized in the rejection of claims 5-8.

In view of the foregoing amendments and remarks, Applicants submit that claims 5-8 are in condition for allowance. Accordingly, early allowance of claims 5-8 is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under
~~37 CFR 1.136. Please charge any shortage in fees due in connection with the filing~~
of this paper, including extension of time fees, or credit any overpayment of fees, to
the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No.
01-2135 (566.37037X00).

Respectfully submitted,

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